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In re Application of :
SABANATHAN, Thirumani :
Application No.: 09/762,692 :
PCT No.: PCT/GB98/00652 :
Int. Filing Date: 03 March 1998 :
Priority Date: 30 April 1997 :
Attorney Docket No.: 007-001 :
For: OCCLUSION DEVICE :
DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on applicant's "Request for Reconsideration of Denial of Petition under 37 CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136" filed in the Patent and Trademark Office (PTO) on 10 June 2002.

BACKGROUND

On 03 March 1998, applicant filed international application no. PCT/GB98/00652 which claimed a priority date of 30 April 1997 and which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 November 1998.

A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 30 October 1999.

On 09 February 2001, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, inter alia, by: the basic national fee, a copy of the international application, and a petition seeking revival under 37 CFR 1.137(b) with the appropriate fee. The petition was dismissed in a decision dated 24 May 2001 because the delay was not considered to be unintentional.

On 24 September 2001, applicant responded to the 24 May 2001 decision by filing the "Renewed Petition under CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136." The petition was dismissed without prejudice in a decision dated 15 February 2002 because the delay was not considered to be unintentional.

On 10 June 2002, applicant responded to the 15 February 2002 decision by filing the present "Request for Reconsideration of Denial of Petition under 37 CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136."

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be filed promptly after applicant becomes aware of the abandonment and must be accompanied by: (1) the required reply, unless previously filed, (2) the petition fee required by law, (3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional and (4) a terminal disclaimer (for applications filed before 08 June 1995).

Applicant has satisfied items (1) and (2), as to item (4), since the application was filed after 08 June 1996, a terminal disclaimer is not required.

With regards to item (3) above, a review of the present renewed petition reveals that applicant has not provided the necessary evidence that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. In the Petition to Revive dated 09 February 2001, Mark Lunt declared that, "[d]ue to my mistaken belief that the (Bradford Hospitals NHS Trust) Trust owned all patent rights, I followed the instructions by the Trust not to file a U.S. National Phase Application." Mr. Lunt's statement was construed as being a deliberately course of action to not persist in seeking the revival of the abandoned application. In the Renewed Petition to Revive filed 24 September 2001, petitioner asserted that Mr. Lunt did not have the authority to abandon the application without the consent of Ms. Sabanathan. In a decision dated 15 February 2002, the PCT Legal Office held that "Mr. Lunt had authority to prosecute (or not prosecute) the application and Ms. Sabanathan is bound by the actions of Mr. Lunt."

Petitioner asserts in the (second) renewed Petition to Revive filed 10 June 2002 that, "Bradford Hospital had a fiduciary duty to Mrs. Sabanathan and assumed an affirmative obligation to prosecute both British and foreign patent on Mrs. Sabanathan's behalf applications on behalf." The PCT Legal Office respectfully disagrees with petitioner's assertion. As stated in the decision dated 15 February 2002, the papers show that Ms. Sabanathan and Bradford Hospitals NHS Trust had more than a fiduciary relationship and that Mr. Lunt had the authority to prosecute the above identified application. Additionally, Thirmunani Sabanathan states in her declaration that "if I cooperated with any patent application, then Bradford would pay for prosecuting the PCT Application, including Mr. Lunts' fee, and in the event the invention was commercialized and that I would share royalties equally with Bradford." Further, in Susan E. Clark's letter dated 31 March 1998 to David Jackson, Chief Executive of Bradford Hospital, states that "[a]s I understand it, any financial benefit obtained through the commercial development of the device, the exploitation of a patent or any other commercial interest in the product would . . . be split 50:50 between the Trust and the Sabanathan estate." Therefore, Ms. Sabanathan and Bradford Hospitals NHS Trust had more than a fiduciary relationship and that Mr. Lunt had the authority to prosecute (or not prosecute) the above identified application.

Additionally, petitioner avers that Mrs. Sabanathan is the true owner of this invention and the patent application. Petitioner relies upon an United Kingdom Patent Office entitlement decision which determined, on 21 January 2001, that "Bradford Hospital did not at any time have any ownership rights or interest in the invention or patent application." However, a review of the petition papers reveal that the United Kingdom Patent Office may not have been provided with all the information and pertinent documents. For example, was the U.K. Patent Office provided with the "Agreement" executed 06 June 2000 by NHS Bradford and Thurumani Sabanathan which assigns all rights, title and interest of the invention to the assignee, The Foundry? Moreover, it appears that NHS Bradford agreed not to contest the entitlement of the invention so that Mrs. Sabanathan would not be bound by NHS Bradford decision not to prosecute the above identified application.

Lastly, even if the PCT Legal Office had agreed with the petitioner that Mrs. Sabanathan is the true owner of the application and that NHS Bradford breached its fiduciary duty, a review of the application file reveals that the entire delay cannot be held to be unintentional. As stated above, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 30 October 1999. On 06 June 2000, Thurumani Sabanathan executed "Agreement" which states that "the Foundry acknowledges that it is aware that the period within which national/regional phase entry of the international application no. PCT/GB98/00653 must normally be effected may have passed with such phases having entered and therefore such application may not exist . . ." Upon execution of the agreement, Mrs. Sabanathan became aware of the abandonment of application no. PCT/GB98/00653 and should have filed a petition to revive under 37 CFR 1.137 to protect her rights in the invention. Therefore, in view of the deliberately chosen course of action to not persist in seeking the revival of the abandoned application, the delay cannot be considered to be unintentional, and the petition may not be properly granted.

Since applicant has not met the requirements for revival of an application under 37 CFR 1.137(b), revival at this time would not be proper.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The application remains **ABANDONED** with regards to national stage processing in the United States.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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